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EXPEDITED PROCEDURE
EXAMINING GROUP 3711

PATENT
0020-4699P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Kazunari YOSHIDA et al. Conf.: 2420

Appl. No.: 09/551,871 Group: 3711

Filed: April 18, 2000 Examiner: A. HUNTER

For: MULTI-PIECE SOLID GOLF BALL

PETITION AGAINST REFUSAL TO ENTER AMENDMENT
UNDER 37 C.F.R. § 1.127 AND 37 C.F.R. § 1.181

MS AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

April 1, 2005

Sir:

This is a Petition under 37 C.F.R. 1.127 and 1.181 from the refusal by the Patent Examiner to enter the claim amendments submitted in the Reply under 37 C.F.R. 1.116 filed February 2, 2005. A review of the facts below indicates that the claim amendments in the February 2nd Reply merely complied with "requirements of form" to place all claims into allowable form, such that the Examiner's act in refusing entry of the claim amendments was incorrect. Consequently, it is requested that a Petition Decision issue which requires entry of the claim amendments into the record so that the present application may

proceed to grant as a patent, and so that Applicants are not required to unnecessarily file and pay the fees for a Request for Continued Examination (RCE).

Summary of Relevant Facts

The Reply filed February 2nd included: [1] changes to pending patent claims which placed the claims into allowable form in view of the Final Office Action of November 2, 2004; and [2] the submission of a new allowable independent claim 20 with allowable dependent claims 21-36 all depending from this allowable claim. The Advisory Action of March 11, 2005 refused entry of these claim amendments asserting that the new claims 20-36 "did not [simplify] issues" and that generally additional claims are not considered after the Final Office Action issues.

The Final Office Action of November 2nd indicated the allowability of dependent claims 4 and 7 (both depending from claim 1 and reciting different features). A review of the claim amendments in the Reply of February 2nd shows that these amendments included: (a) forming a first set of claims by inserting allowable claim 4 into claim 1 so that claim 1 became allowable together with all the pending dependent claims 3 and 5-19 which all depended from claim 1; and (b) combining claim 1 with allowable claim 7 to form a second set of claims including new independent, allowable claim 20, with all of new dependent claims 21-36 depending from

claim 20 and **reciting the identical features of pending claims 3, 5, 6, and 8-19, as well as now cancelled claim 4.**

Points to Be Reviewed

The main point to be reviewed is the refusal by the Examiner to enter the claim amendments of the Reply of February 2nd. It appears that the only claim amendments refused entry were the submissions of new independent claim 20 (combination of allowable claim 7 with pending claim 1) and new dependent claims 21-36 (all depending from claim 20). As noted above, the reasons given were that the submission of these new claims did not simplify issues and that new claims are generally not considered after a Final Office Action.

Action Requested

It is requested that a Petition Decision issue which directs the Patent Examiner to enter the claim amendments of the Reply of February 2nd. This will allow the present application to proceed to allowance and will allow Applicants to avoid having to unnecessarily file and pay the fees for a RCE in order to have the claim amendments entered.

Applicable Standards regarding Refusal of Entry of Claim Amendments
after Final Office Action

A first applicable standard for determining whether refusal to enter claim amendments after a Final Office Action is indicated in 37 C.F.R. 1.116 which states that, "... amendments may be made ... complying with any requirements of form expressly set forth in a previous Office [A]ction ..." It is clear from the facts above, that the submission of new claims 20-36 complied with "requirements of form" by combining clearly allowable features in independent claim 20 (combination of previous claims 7 and 1) and submitting dependent claims 21-36 (all depending from claim 20) which recited features identical to pending claims already considered by the Examiner.

A second applicable standard for determining whether refusal to enter claim amendments after a Final Office Action is indicated in MPEP 714.13, III (MPEP of Rev. 2, May 2004, page 700-223) which states that examples of reasons for non-entry include: (A) the amendments would not avoid any outstanding rejections; (B) the amendments would raise the issue of "new matter"; (C) the amendments would present "new issues"; or (D) the amendments present additional claims without canceling any finally rejected claims such that the application is not placed into "better condition for appeal". With regard to (D), the decision *Ex parte Wirt*, 1905 C.D. 247 is cited. Examples (A), (B) and (C) all

clearly do not apply here, since the claims amendments of the February 2nd Reply avoided all outstanding rejections and did not raise any "new matter" issues or even any "new issues" at all. Example (D) also does not apply here, since the claim amendments presented new claims 20-36 which were all allowable according to the Final Office Action such that all of these claims were clearly placed into "better condition for appeal". In addition, it is noted that the *Wirt* decision does not apply, since in that case additional claims were added without any of the rejected claims being cancelled; whereas in contrast, in the present situation all rejected claims have been removed (effectively "cancelled") and only clearly allowable claims raising no new issues have been added.

Another indirect standard is mentioned in MPEP 714.13, II (page 700-222) which indicates that claim amendments after the Final Office Action are not entered as a matter of right and must comply with 37 C.F.R. 1.116(c), except in situations where the amendments adopt Examiner suggestions, remove issues for appeal, or in some other way require only a "cursory review" by the Examiner. In the present situation, it is clear that 37 C.F.R. 1.116(c) does not apply, since these amendments do not "touch the merits" of the application. That is, the amendments merely combine allowable claims together, recite no new features not already considered, and raise no new issues. In any case, even applying the indirect

standards mentioned above, it is clear that the claim amendments adopt Examiner suggestions, remove all issues and require only a "cursory review" by the Examiner.

In summary, the claim amendments in the Reply of February 2nd merely combined allowable dependent claims with non-allowable independent base claims. These claim amendments: [i] included no new claim features (that had not already been considered); [ii] raised no new examination issues; [iii] complied with the "requirements of form" concerning the allowable subject matter identified in the Final Office Action of November 2nd; [iv] avoided all rejections and raised no "new matter" issues; [v] adopted the Examiner's suggestions for placing claims into allowable form; [vi] removed all issues for appeal (by placing all claims into allowable form) so as to place the claims into "better condition for appeal"; [vii] simplified the issues by removing all bases for the previous claim rejections; and [viii] required only a "cursory review" by the Examiner since he had previously considered all the features recited in all the claims.

Conclusion

It is submitted for the reasons stated above that the refusal by the Patent Examiner to enter the claim amendments of the Reply of February 2nd with incorrect, such that a Petition Decision should

issue which directs the Examiner to enter these claim amendments in order to place this application into condition for allowance.

If any questions arise regarding the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

It is believed that this Petition under 37 C.F.R. 1.127 and 1.181 does not require any fee.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By

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